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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,677	06/26/2000	Raymond J. Mueller	00-004	2610

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EXAMINER

HARLE, JENNIFER I

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/603,677

Applicant(s)

MUELLER ET AL.

Examiner

Jennifer I. Harle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/26/00.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-112 are pending. Claims 1-112 are subject to a multiplicity rejection.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

For Purposes of clarity and reasonableness of scope, the claims have been divided into three separate groups:

- I. A. Claims 1-49 and 109-111, drawn to a method for conducting a transaction where information regarding a transaction is received.
B. Claims 77-84, drawn to a system/computer readable medium/article of manufacture/apparatus for conducting a transaction where information regarding a transaction is received.
- II. A. Claims 50-69, drawn to a method for conducting a transaction where information regarding a sale is received, classified in class 705, subclass 104.1.
B. Claims 85-100, drawn to a system/computer readable medium/article of manufacture/apparatus for conducting a transaction where information regarding a sale is received.
- III. A. Claims 70-76, and 112 drawn to a method of conducting a transaction where processing of a product/conducting a sale occurs.
B. Claims 101-108, drawn to a system/ computer readable medium/article of manufacture/apparatus for conducting a transaction where processing of a product/conducting a sale occurs.

1. Claims 1-112 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A telephone call was made to Dean Alderucci on March 3, 2003 regarding the multiplicity rejection and apprising him of the complexity regarding the selection of a reasonable number of claims in this case. Upon discussion with the examiner, Applicant agreed that the requirement could be set forth in writing for his consideration and selection.

All claims are rejected based on undue multiplicity under 37 CFR 1.75(b). According to MPEP 2173.05 (n), an unreasonable number of claims, that is unreasonable in view of the nature and scope of applicant's invention and the state of the art, may afford a basis for a rejection on the ground of multiplicity. It is noted that Applicant's claims are repetitious and multiplied with a net result of which is to confuse rather than to clarify. Therefore, the claims are rejected on undue multiplicity based on 35 U.S.C. § 112, 2nd paragraph. It is noted that this application includes 47 pages directed to the "Detailed Description" and 25 pages to the "Claims", wherein 112 claims are currently pending. It is further noted that the application was restricted and an election was made of Group 1 (original claims 1-19). Additionally, it noted that there are 42 independent claims, with the 11 method claims, 22 system/apparatus/article of manufacture, and 8 computer readable medium claims directed toward substantially the same subject matter. It is nearly impossible to determine the differences between the independent claims. Additionally, the repetitious nature of the dependent claims is also confusing and clouds the issues with undue multiplicity. It is noted that the art of conducting a transaction for upselling is not terribly

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complicated and it is unclear why such a large number of overlapping and often redundant claims are necessary for such a device. The art is full of prior art references that demonstrate that a reasonable number of claims for the snowboard binding art is approximately thirty claims. Therefore, the Examiner believes that thirty claims is sufficient to properly define applicant's invention. Applicant is therefore directed to select 10 claims from Groups I, II and III for a total of 30 claims.

2. Claims 9-11 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: setting forth to what the filter, rule, forced option is being applied. Without setting forth to what the filter, rule, forced option is being applied, these items could just be sitting there and looping or being applied to any step in the method of claim 1, thus creating ambiguity. Additionally, if the applying step is selected without the establishing step, there is no filter, rule, forced option that exists to apply.

3. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: creating the databases, i.e. transaction, product, potential supplemental products, and user. Until the database is created, the steps of maintaining, updating, accessing and populating a database cannot occur.

4. Claims 34-35 and 36 and 39 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: ensuring that there are at least two

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supplemental products to choose from in the base claim. As there could be only one supplemental product, there would not be another product to score higher and then be chosen.

5. Claim 64 recites the limitation "said supplemental products" in lines 1 and 2.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 29-30 and 32-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The limitation of either a "cashier" or a "user" specifically limits the claim to the human body. A claim directed to or including within its scope a human being or attributes of a human being is not patentable subject matter. See MPEP §2105 and 1077 OG 24 (April 21, 1987).

7. Claims 1-76 and 109-112 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences,

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for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, there is no recitation or indication that the technological arts are involved in the method.

Specifically, claims 1-76 and 109-112 only recite an abstract idea. The recited steps of conducting a transaction through the receipt of information, determination of a pool of at least one possible supplemental product, scoring of the supplemental product from the pool and providing an indication of at least one supplemental product selected from the pool with ancillary features that include a database, a cashier, a user, rules filters, options, data processing, etc. These steps only constitute an idea of how to effectuate conducting a transaction. All of these steps can be performed by a human being and done by hand and utilizing just pencil and paper.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention provides for an indication of at least one supplemental product selected from the pool (i.e., repeatable, useful and tangible).

Although the recited process produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1-76 and 109-112 are deemed to be directed to non-statutory subject matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is (703) 306-2906.


The examiner can normally be reached on Monday - Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Jennifer Ione Harle
March 10, 2003


Richard Chilcot
Supervisory Patent Examiner
Technology Center: 2850
3620